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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,667	01/24/2002	Hidehiko Kawakami	11-078	8425
23400 7590 06/04/2007 POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/053,667	<b>Applicant(s)</b> KAWAKAMI, HIDEHIKO	
	<b>Examiner</b> Namrata Boveja	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/24/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 01/24/2002.
2. Claims 1-17 are presented for examination.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-20 are rejected under 102(b) as being anticipated by Torii et al. (Patent Number 5,761,308 hereinafter Torii).

In reference to claims 1 and 14, Torii teaches a consuming device for effecting a specific function by using a content of an information package containing a plurality of charged contents while permitting a user to get a refund in response to the amount of actually used contents, the consuming device comprising: means for using said content of said information package (i.e. a user terminal) (col. 1 lines 65 to col. 2 lines 6 and Figures 1, 2, and 6); means for storing information to know whether each of said charged contents has been used so far (i.e. whether specific content from the CD has been normally installed) (col. 4 lines 47-52, col. 7 lines 44-54, col. 10 lines 24-52, col. 13 lines 25-55, and Figure 3); means, responsive to a determination that said content to be used has never been used, for registering to the effect as said information (col. 9 lines 60 to col. 10 lines 52, col. 11 lines 25-33, and col. 13 lines 25-55); and means,

responsive to a determination that the user has already got said refund and said content to be used has never been used, for prohibiting a use of said content to be used (i.e. using a check code it can be determined if the user should be able to use the software that he paid for or not be able to use the software he got a refund for already) (col. 3 lines 12 to col. 5 lines 26).

4. In reference to claim 2, Torii teaches a consuming device further comprising means, responsive to a refund request from the user, for sending a signal indicative of said refund request and a user ID of the user to a vendor side from which the user has bought said information package (col. 4 lines 4-37).

5. In reference to claim 3, Torii teaches a consuming device wherein said means for storing information comprises means for storing a list of identifiers (IDs) of the used contents having been used so far, and wherein said registering means includes means for adding an ID of said content to be used (col. 7 lines 44-54, col. 8 lines 1-18 and 55-59).

6. In reference to claim 16, Torii teaches a program, run on a computer, for effecting a specific function by using a content of an information package containing a plurality of charged contents while permitting a user to get a refund in response to the amount of actually used contents, the program comprising the functions of: using said content of said information package (col. 7 lines 55-67); storing a list of IDs of charged contents having been used so far in such a way as prevents said list from being altered by any person, and if said content has never been used, adding an ID of said content to said list (col. 7 lines 44-54, col. 8 lines 1-18 and 55-59).

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7. In reference to claim 17, Torii teaches an information package for use in a computer based system; the information package comprising: a plurality of charged contents (col. 6 lines 14-21); identifiers (IDs) assigned to respective charged contents (i.e. a content id is registered) (col. 8 lines 55-59); a program for effecting a specific function by using one of the charged contents and permitting a user to get a refund in response to the amount of actually used contents, the program comprising the functions of: using said content of said information package (col. 7 lines 55-67); storing a list of IDs of charged contents having been used so far in such a way as prevents said list from being altered by any person, and if said content has never been used, adding an ID of said content to said list (col. 7 lines 44-54, col. 8 lines 1-18 and 55-59).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 103(a) as being anticipated by Torii in view of Barber.  
(Patent Number 6,349,288 hereinafter Barber).

In reference to claim 6, Torii does not specifically teach a consuming device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content. Barber explicitly teaches a consuming

device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content (col. 3 lines 1-39). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention a user selection means and a price display means to give the users and option to pick and choose what contents they want to gain access to and to let the users know of the particular price associated with the each content installation ahead of time.

9. Claims 8 and 14 are rejected under 103(a) as being anticipated by Torii in view of Applicant's background.

In reference to claim 8, Torii teaches means for using said content of said information package (i.e. a user terminal) (col. 1 lines 65 to col. 2 lines 6 and Figures 1, 2, and 6); means for storing information to know whether each of said charged contents has been used so far (i.e. whether specific content from the CD has been normally installed) (col. 4 lines 47-52, col. 7 lines 44-54, col. 10 lines 24-52, col. 13 lines 25-55, and Figure 3); means, responsive to a determination that said content to be used has never been used, for registering to the effect as said information (col. 9 lines 60 to col. 10 lines 52, col. 11 lines 25-33, and col. 13 lines 25-55); and means, responsive to a determination that the user has already got said refund and said content to be used has never been used, for prohibiting a use of said content to be used (i.e. using a check code it can be determined if the user should be able to use the software that he paid for

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or not be able to use the software he got a refund for already) (col. 3 lines 12 to col. 5 lines 26).

Torii does not teach the information package to include maps. Applicant's background on page 1 lines 12-22 teach that an information package can include an atlas CD-ROM with maps covering a nation for use in a car navigation system (intended use not given any weight). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual maps similar to customized billing for use of each song.

10. In reference to claim 14, Torii teaches means responsive to a refund request from the user, for sending a signal indicative of said refund request and a user ID of the user to a vendor side from which the user has bought said information package (col. 4 lines 4-37).

11. Claims 9 and 10 are rejected under 103(a) as being anticipated by Torii in view of Barber and further in view of Applicant's background.

In reference to claim 9, Torii does not specifically teach a consuming device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content. Barber explicitly teaches a consuming device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content (col. 3 lines 1-39). It would have been

obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention a user selection means and a price display means to give the users and option to pick and choose what contents they want to gain access to and to let the users know of the particular price associated with the each content installation ahead of time.

Torii does not teach the information package to include maps. Applicant's background on page 1 lines 12-22 teach that an information package can include an atlas CD-ROM with maps covering a nation for use in a car navigation system (intended use not given any weight). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual maps similar to customized billing for use of each song.

12. In reference to claim 10, Torii does not specifically teach a consuming device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content. Barber explicitly teaches a consuming device, further comprising selection means for permitting the user to select, as said content, a desired one of said charged contents, said selection means including means for displaying the price of said selected content (col. 3 lines 1-39). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention a user selection means and a price display means to give the users and option to pick and choose what contents they want to gain access to and to



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let the users know of the particular price associated with the each content installation ahead of time.

13. Claims 4, 5, 7, 11, and 15 are rejected under 103(a) as being anticipated by Torii in view of Official Notice.

In respect to claims 4 and 5, Torii does not teach a consuming device, wherein said means for prohibiting a use of said content includes a flag indicative of whether the user has already got said refund and the means for setting said flag to 1. Official Notice is taken that it is old and well known to flag items with an indicator for which the user has already received a refund to prevent the user from receiving that specific amount of refund twice for a single item. For example, when a user goes to a retailer to return something and the barcode on the receipt is scanned, once the item has been returned, the user will not be able to return it again, since it would show up as already been returned in the register. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of a flag and an indicator to prevent the return of an already returned file and therefore to prevent fraud, which is one of Torii's objectives.

14. In respect to claim 7, Torii does not teach a consuming device, further comprising means, responsive to a predetermined input by the user, for displaying an expected amount of a refund that the user could receive at present. Official Notice is taken that it is old and well known to display an amount of a refund the user could receive at present to enable the user to decide if he would like to continue receiving the content or if he would still rather opt for a refund. For example, colleges with regard to tuition

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reimbursement do this after the course has started where the amount of refund a student can receive decreases with time, since the student has had the opportunity to learn the information taught in the course over time. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of a flag and an indicator to prevent the return of an already returned file and therefore to prevent fraud, which is one of Torii's objectives.

15. In respect to claim 11, Torii does not teach a navigation system, wherein said means for calculating said price includes means for correcting said calculated price according to the elapsed time from release of said optical disc. Official Notice is taken that it is old and well known to calculate a price according to the elapsed time from release of said optical disc to enable the retailer to move obsolete inventory and to make room for new releases. For example, retailers who sell old movies for a discounted price when new part II or III of those movies are released do this. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of correcting said calculated price according to the elapsed time from release of said optical disc to enable users to receive a discount for purchasing obsolete software and to enable the retailer to continue making some revenue with the sale of these products while focusing their energy on the sale of new products.

16. In respect to claim 15, Torii does not teach a navigation system, further comprising: means for permitting the user to issue a flag resetting command; means, responsive to a reception of a notice of a refund fee, for asking the user if the user

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agrees to pay said refund fee; means, responsive to an agreement by the user, for prompting the user to do a further operation to reset said flag; and means, responsive to said further operation, for resetting said flag. Official Notice is taken that it is old and well known to enable a user to reset a flag in order to gain access to an application. For example, if a gym member fails to pay his monthly bill, his access to the gym may be blocked by the use of an access flag in the gym's check in system until he makes the payment upon which the access is restored. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to enable the user to restore a flag and access the content to enable the user who has made payments to access the purchased contents.

17. Claims 12 and 13 are rejected under 103(a) as being anticipated by Torii in view of the Applicant's Background and further in view of Official Notice.

In respect to claim 12, Torii does not teach the information package to include maps. Applicant's background on page 1 lines 12-22 teach that an information package can include an atlas CD-ROM with maps covering a nation for use in a car navigation system (intended use not given any weight). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual maps similar to customized billing for use of each song.

Torii also does not teach a consuming device, wherein said means for prohibiting a use of said content includes a flag indicative of whether the user has already got said refund. Official Notice is taken that it is old and well known to flag items with an

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indicator for which the user has already received a refund to prevent the user from receiving that specific amount of refund twice for a single item. For example, when a user goes to a retailer to return something and the barcode on the receipt is scanned, once the item has been returned, the user will not be able to return it again, since it would show up as already been returned in the register. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of a flag and an indicator to prevent the return of an already returned file and therefore to prevent fraud, which is one of Torii's objectives.

18. In respect to claim 13, Torii does not teach the information package to include maps. Applicant's background on page 1 lines 12-22 teach that an information package can include an atlas CD-ROM with maps covering a nation for use in a car navigation system (intended use not given any weight). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual maps similar to customized billing for use of each song.

Torii also does not teach a navigation system, further comprising flag setting means for permitting the user to set said flag so as to cause said flag to indicate that no new map is available. Official Notice is taken that it is old and well known to flag items with an indicator that no new version is available to enable the user to know that he is buying the latest version of the product. For example, bookstore databases frequently indicate if there are more than one versions available for a text (i.e. 2006 rules or 2007 rules) and if they are on the shelves or have been ordered to enable the user to decide

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if he should carry out his purchase for that textbook. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of a flag and an indicator to indicate that the version being sold is the latest version and no new version is available so that the user can make his purchase with confidence knowing that he is buying the most up to date version of the software.

**Point of contact**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



N.B.

May 24<sup>th</sup>, 2007

RETTA YEHDEGA  
PRIMARY EXAMINER